



UNITED STATES PATENT AND TRADEMARK OFFICE

AL

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,754	01/30/2002	Jeffry B. Skiba	125827-1000	8210

7590 02/09/2005

Gardere Wynne Sewell LLP
3000 Thanksgiving Tower
Suite 3000
1601 Elm Street
Dallas, TX 75201-4767

EXAMINER

ANDERSON, CATHARINE L

ART UNIT PAPER NUMBER

3761

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/060,754

Applicant(s)

SKIBA ET AL.

Examiner

C. Lynne Anderson

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-29 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/6/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 1-18 in the reply filed on 12 November 2004 is acknowledged. The traversal is on the ground(s) that the product and process of using are not distinct inventions. This is found persuasive.

Process claims 19-20 are hereby rejoined and fully examined for patentability.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-7, 9, 12-13, 15, 17, 19-23, 25, and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Kang (5,807,357).

Kang discloses an apparatus for delivering medicine to tissues, as shown in figure 2, comprising a mask 10 to be worn around the eyes, the mask 10 comprising fog outlets (shown as holes in figure 3, but not numbered). An atomizer 20 atomizes medicine 90 into a fog to be discharged from the fog outlets.

With respect to claim 2, the atomizer 20 comprises an ultrasonic atomizer, as disclosed in column 2, lines 29-32.

With respect to claim 3, the atomizer 20 comprises a nozzle 11, as shown in figure 3.

With respect to claim 4, the atomizer 20 is a nebulizer, as disclosed in column 1, line 54.

With respect to claim 6, the atomizer 20 comprises a medication chamber 71, as shown in figure 2.

With respect to claim 7, a conduit 11 is in fluid communication with the atomizer 20 and fog outlets, as shown in figure 3.

With respect to claim 9, a propellant source 30 is in fluid communication with the atomizer, as shown in figure 3.

With respect to claim 12, a power supply 40 is connected to the atomizer 20.

With respect to claim 13, the power supply 40 comprises batteries, as disclosed in column 1, line 60.

With respect to claim 15, the apparatus comprises a mask 10 having a transparent face mask 12 to be worn around the eyes, fog outlets (shown as holes in figure 3, but not numbered), an atomizer 20 to atomize medicine 90 into a fog, a medication chamber 71, a power supply 40, a propellant source 30, and a conduit 11.

With respect to claim 17, the power supply 40 comprises a battery, as disclosed in column 1, line 60.

With respect to claims 19 and 20, the method of administering medications to the eyes by nebulizing a medication to form a fog and contacting the fog with the eyes is disclosed in column 2, lines 27-36.

Art Unit: 3761

With respect to claim 21, the apparatus comprises a device 10 comprising fog outlets (shown as holes in figure 3, but not numbered), and an atomizer 20 in fluid communication with the fog outlets.

With respect to claim 22, the atomizer 20 is a nebulizer, as disclosed in column 1, line 54.

With respect to claim 23, a conduit 11 is in fluid communication with the fog outlets, as shown in figure 3.

With respect to claim 25, a propellant source 30 is in fluid communication with the atomizer 20.

With respect to claim 28, a power supply 40 is connected to the atomizer 20.

With respect to claim 29, the power supply 40 comprises batteries, as disclosed in column 1, line 60.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kang (5,807,357) as applied to claim 1 above.

Kang discloses all aspects of the claimed invention with the exception of the atomizer being a stirrer. Stirrers are well-known in the art as being suitable atomizers

Art Unit: 3761

comparable to nebulizers. It would therefore be obvious to one of ordinary skill in the art at the time of invention to make the apparatus of Kang with a stirrer.

Claims 8, 18, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kang (5,807,357) as applied to claims 1, 15, and 21 above, and further in view of Dykstra et al. (5,935,982).

Kang discloses all aspects of the claimed invention but remains silent as to the size of the liquid droplets of the fog. Dykstra discloses administering a medicine to the eyes, the medicine being in the form of liquid droplets having a size of less than 5 microns, as described in column 12, lines 13-15 and 36-37. It would therefore be obvious to one of ordinary skill in the art at the time of invention to make the droplets of Kang less than 5 microns, since Kang teaches less than 5 microns as a suitable size for medicine being delivered to the eyes.

Claims 10-11 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kang (5,807,357) as applied to claims 1 and 21 above.

Kang discloses all aspects of the claimed invention with the exception of the propellant source comprising a compressed gas canister or a pump. Kang discloses the propellant source is a fan, as described in column 2, lines 33-35. It is well-known in the art that a compressed gas canister or pump perform a comparable function to a fan, and it would therefore be obvious to one of ordinary skill in the art at the time of invention to construct the apparatus of Kang with a compressed gas canister or a pump.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kang (5,807,357).

Kang discloses all aspects of the claimed invention with the exception of the power source being a wall outlet. It is well-known in the art that a wall outlet is a comparable power source to a battery, and it would therefore be obvious to one of ordinary skill in the art at the time of invention to construct the apparatus of Kang with the power source being a wall outlet.

Allowable Subject Matter

Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patents 5,368,582 and 5,627,611 disclose masks adapted to deliver medicine to the eyes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Lynne Anderson whose telephone number is (571) 272-4932. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3761

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CUA

cla

February 2, 2005



Larry I. Schwartz
Supervisory Patent Examiner
Group 3700